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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/825,623 | 04/03/2001 | Robert Brian Dianda | 50001-10370 | 3829 |
| 47377 | 7590 | 06/23/2005 | EXAMINER | |
| JENNER & BLOCK LLP ONE IBM PLAZA CHICAGO, IL 60611 | | | | JUNTIMA, NITTAYA |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 2663 |

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/825,623 | DIANDA ET AL. |
| | Examiner Nittaya Juntima | Art Unit 2663 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 31 January 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 8 is/are allowed.

6) Claim(s) 1-7 and 9-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 31 January 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. _____
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ 5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed on 1/31/2005.
2. The objections to the drawings and claims are withdrawn in view of applicant's amendment.
3. Claim 8 is allowed.
4. Claims 1-7, and 9-15 remain rejected under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (Fig. 1) in view of Rogers et al. (USPN 5,617,471).

Per claim 1, as shown in Fig. 1, the admitted prior art teaches that a first ATM call (124) is established between a first party (120) and a second party (116) and a second ATM call (128) is established between the second party (116) and a third party (118), wherein the first ATM call includes a plurality of segments (124a-124d) that are coupled to a plurality of ATM switches (ATM switches 1, 2, and 3) to provide a virtual connection (an ATM connection must be established to accommodate ATM call 124), and wherein the second ATM call includes a plurality of segments (128a-128d) that are coupled to a plurality of ATM switches (ATM switches 1, 2,

and 4) to provide a virtual connection (an ATM connection must be established to accommodate ATM call 128). See page 2, ll 11-page 3, ll 1-6.

However, the admitted prior fails to teach the method steps as recited in the claim.

In an analogous art, Figs. 1 and 2, Rogers et al. teach a well known concept of call transfer function implemented in the telecommunication system, i.e. a conventional circuit-switched system where a user is involved in two independent calls and the call transfer is initiated by the user to connect the two calls together and disconnecting the user from the calls (Abstract). The call transfer function includes the following steps:

a switch (switch A) coupled to a second party (user A) receiving a message (a message sent to switch A to carry out the transfer) to transfer a first call (a call between user A and user B) to a second call (a call between user A and user C) to connect the first party (user B) and a third party (user C);

the switch (switch A) connecting a first segment (call leg A-B 3) of the first call to a first segment (call leg A-C 5) of the second call (a call between user A and user C);

the switch (switch A) releasing a second segment (voice channel 13) of the first call (a call between user A and user B) that extends from the switch (switch A) to the second party (user A); and

the switch (switch A) releasing a second segment (voice channel 15) of the second call (a call between user A and user C) that extends from the switch (switch A) to the second party (user A). See col. 3, ll 23-30, 38-40, 47-51, 60-65, and col. 4, ll 5-24.

Given the teaching of Rogers et al., a person of ordinary skill in the art would have been motivated to adapt and apply the well known concept of a call transfer function, i.e. receiving a

message to transfer the first call to the second call, connecting a first segment of the first call to a first second of the second call, releasing the respective extending segments of the first call and second call, in the ATM system of the admitted prior art. Since both networks of Rogers et al. (Fig. 1) and the admitted prior art (Fig. 1) are connection oriented and support call transfer option, at the time the invention was made, therefore, it would have been obvious to one skilled in the art adapt and apply the call transfer function of Rogers et al. to the admitted prior art to obtain a method for transferring an ATM call as recited in claim 1. The motivation/suggestion to do so would have been to make the network facilities available for additional calls to the second party, i.e. user 116, as taught by Rogers et al. (col. 4, ll 23-24).

Per claims 2 and 3, the admitted prior art does not teach that the message includes a first identifier for the first ATM call and a second identifier for the second ATM call wherein the first identifier is a call reference for the first ATM call and the second identifier is a call reference for the second ATM call.

Rogers et al. teach that the message (a message sent to switch A to carry out the transfer) includes a first identifier (call leg A-B 3) for the first call and a second identifier (call leg A-C 5) for the second call, wherein the first identifier is a call reference for the first call and the second identifier is a call reference for the second call (a message sent to switch A to carry out the transfer must include call legs A-B 3 and A-C 5 in order for the call legs to be bridged, col. 3, ll 38-40 and col. 4, ll 18-24).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of the admitted prior art to include the that the message includes a first identifier for the first ATM call and a second identifier for the second ATM call,

wherein the first identifier is a call reference for the first ATM call and the second identifier is a call reference for the ATM second call in order to inform the switch which calls are part of the transfer as taught by Rogers et al. (col. 3, ll 38-40).

Per claim 4, as shown in Fig. 1, the admitted art teaches that the second party (116) is coupled to the ATM switch (ATM switch 1) by a media access gateway (MAG 102 connecting to 116), but does not explicitly teach that the media access gateway sends the message to the ATM switch. However, Fig. 1 of the admitted prior art shows that the media access gateway 102 is connected and communicated to ATM switch 1, and Rogers et al. teach that the message to transfer (the transfer request) is sent from the CPE 4 to the switch A in Fig. 1 (“User-A 2 initiates the call transfer by notifying switch-A 6 of the transfer request,” col. 3, ll 38-40 and “User-A’s CPE sends a message to switch-A 6 to carry out the transfer,” col. 4, ll 18-20). Therefore, it would have been obvious to one skilled in the art to further adapt and apply the teaching of Rogers into the teaching of the admitted prior art to include sending a message transfer to the switch such that the media access gateway would send the message to the ATM switch in order for the message, i.e. transfer request, to initiate the call transfer by notifying the switch.

Per claim 5, as shown in Fig. 1, the admitted prior art discloses that the media access gateway is coupled to a call control entity (CCE 104 connecting to MAG 102 which is connected to telephone 116) that receives a request from the second party (116) to transfer the first ATM call (124) to the second ATM call (128) and wherein the media gateway generates a message (a message to instruct ATM switch 1 that a new ATM establishment is needed) under control of the call control entity in response to the request from the second party. See page 1, ll 20-27 and page 3, ll 13-23.

The difference between the claimed message generated by the media gateway in response to the request from the second party is that the message of prior art instructs the media access gateway and thereby the ATM switch 1 to establish a new ATM connect, page 3, ll 17-23, rather than instructing the ATM switch 1 to transfer the first ATM call to the second ATM call in order to connect the first party and the third party as recited in claim 1.

However, in an analogous art, Rogers et al. teach that a message is received in response to the transfer request from user A at switch A to carry out the transfer of the first call between users A and B to the second call between users A and C in order to connect users B and C, see col. 3, ll 38-40 and col. 4, ll 18-24.

Therefore, it would have been obvious to one skilled in the art to modify the teaching of the prior art such that the message generated by the media gateway under control of the call control entity in response to the request from the second party would be to transfer the first ATM call to the second ATM call in order to connect the first party and the third party as recited in claim 1. The motivation/suggest to do so would have been to enable the switch, i.e. ATM switch 1, to bridge the respective call segments and release the appropriate call segments connecting to the switch in order to make network facilities available for additional calls to the user, i.e. user at telephone 116, as taught by Rogers et al. (col. 4, ll 18-24).

Per claim 6, the admitted prior art teaches that the media access gateway is a trunk access gateway.

Per claim 7, the combined teaching of the admitted prior art and Rogers et al. does not explicitly teach that the message is received by the ATM switch via the first segment of the first ATM call. However, since the network structure in Fig. 1 of the admitted prior art shows that

the media access gateway 102 coupled to telephone 116 is connected and communicated to the ATM switch 1 via the segment 124d, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined teaching of the admitted prior art and Rogers et al. to include that the message is received by the ATM switch via the second segment (i.e. 124d) of the first ATM call in order to optimize the utilization of network resources by using the bandwidth of the existing connection such as the second segment of the first call.

Claims 9-13 are apparatus claims corresponding to method claims 1-5, respectively, and therefore are rejected under the same reason set forth in the rejection of claims 1-5, respectively. Note that a caller in claim 9 refers to user at telephone 116 in Fig. 1 of the admitted prior art.

Claims 14 and 15 are apparatus claims containing similar limitations to those of claims 1, 4, and 5, and therefore are rejected under the same reason set forth in the rejection of claims 1, 4, and 5.

Response to Arguments

7. Applicant's arguments filed 1/31/2005 have been fully considered but they are not persuasive.

A. In the remarks regarding independent claims 1, 9, and 14, the applicant argued that Rogers is not analogous art because the teaching of Rogers is not applicable to Fig. 1 of the present application, i.e. the network of Rogers uses the Network Control System to control the switches in the network and to approve call transfer whereas the ATM switches in Fig. 1 do not have a central switch or processor that controls the activity on the network, and there is suggestion or motivation to combine Rogers and Fig. 1.

In response to applicant's argument that Rogers is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, as admitted by the applicant that the present invention and Rogers both disclose telecommunication networks for providing a call transfer service, the network of Rogers is also similar in many ways to that of Fig. 1, for example both networks are connection oriented that connect telephone end users to the networks through switches. The network of Rogers also uses the Network Control System to control the switches in the network and to approve call transfer (col. 3, ll 7-22) which is similar to the usage of call control entity 204, Fig. 3 of the application (specification, page 8, ll 14-27). Therefore, Rogers and the present invention are in the same field of art, i.e. telecommunication.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to adapt and apply the call transfer function of Rogers, i.e. receiving a message to transfer the first call to the second call, connecting a first segment of the first call to a first second of the second call, releasing the respective extending segments of the first call and second call, in the ATM system of the admitted prior art (Fig. 1) to obtain the claimed invention

is to make the network facilities available for additional calls to the second party, i.e. user 116, as taught by Rogers et al. (col. 4, ll 23-24).

For the reasons given above, the rejection of independent claims 1, 9, and 14 and their respective dependent claims is maintained.

B. In the remarks regarding dependent claims 4, 12, and 14, the applicant argued that neither Rogers nor Fig. 1 discloses the limitation that the media access gateway sends the message to transfer.

In response, Fig. 1 of the admitted art shows that the second party (116) is coupled to the ATM switch (ATM switch 1) by a media access gateway (MAG 102 connecting to 116), but does not explicitly teach that the media access gateway sends the message to the ATM switch. However, Rogers teaches that the message to transfer (the transfer request) is sent from the CPE 4 the switch A in Fig. 1 (“User-A 2 initiates the call transfer by notifying switch-A 6 of the transfer request,” col. 3, ll 38-40 and “User-A’s CPE sends a message to switch-A 6 to carry out the transfer,” col. 4, ll 18-20). Therefore, it would have been obvious to one skilled in the art to further adapt and apply the teaching of Rogers into the teaching of the admitted prior art to include sending a message transfer to the switch such that the media access gateway would send the message to the ATM switch in order for the message, i.e. transfer request, to initiate the call transfer by notifying the switch.

Note that how the switch treats the message after receiving it (e.g. forwarding it to NCS as argued by the applicant) is irrelevant as long as the message is sent from a CPE (MAG equivalent) to the switch which reads on the claim limitation. Therefore, the rejection of claims 4, 12, and 14 is sustained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nittaya Juntima
June 13, 2005


RICKY NGO
PRIMARY EXAMINER

6/21/05